

**REMARKS**

This is intended as a full and complete Response to the Office Action dated June 2, 2004, having a shortened statutory period for response set to expire on September 2, 2004. Claims 1-24, 35-55, 57-62, and 64-69 remain pending after entry of this response. Claims 56 and 63 have been cancelled, and claims 64-69 have been added. No new matter has been introduced. Please reconsider the claims pending in the application for reasons discussed herein.

**35 U.S.C. § 102**

Claims 1-20, 24, 35, 36, 38-47, 50, 51, 53-63 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Honea*, U.S. Patent No. 3,978,990. The Examiner states *Honea* discloses an apparatus for positioning a tong. The Examiner states that the apparatus includes the following features:

- A cantilevered extendable boom 16 with the tongs 200 attached to the end thereof.
- An actuating member 26 for extending and retracting the extendable boom.
- A mounting assembly (Figure 2) coupled to an opposite end of the boom.

*Honea* discloses a device having an elongated arm and grapples for engaging and moving logs. Each grapple comprises a pair of barb-ended, crescent shaped grippers. Springs in each gripper cause the barbs to engage and grip the log. Applicant respectfully submits that the "tong" of *Honea* is not the tong contemplated by the Applicant's specification and claims. As used in the Applicant's specification, a tong is capable of making up or breaking out tubulars. *Honea* does not teach, show, or suggest a tong for making up or breaking out tubulars, as recited in claims 35, 38, and 50.

Additionally, *Honea* does not teach, show, or suggest an apparatus for positioning anything proximate a well center. Further, *Honea* does not teach, show, or suggest an apparatus for positioning anything proximate a well center comprising an

actuating member for extending or retracting the extendable structure relative to the well center, as recited in claim 1.

*Honea* does not teach, show, or suggest an apparatus for positioning a tong proximate a well center, as recited in claim 38.

*Honea* does not teach, show, or suggest a method of positioning a tong to make up or break out tubulars. Further, *Honea* does not teach, show, or suggest moving the tong from a first position to a second position, engaging the tubulars with the tong, and one of making up or breaking out a connection of the tubulars, as recited in claim 58.

*Honea* does not teach, show, or suggest a tong assembly for making up or breaking out tubulars. Further, *Honea* does not teach, show, or suggest an extendable boom and a tong for making up or breaking out tubulars mountable at one end of the boom, wherein a center of mass of the tong is alignable with a longitudinal center line of the boom when the tong is mounted on the boom, as recited in claim 62.

*Honea* does not teach, show, or suggest an apparatus for connecting tubulars. Further, *Honea* does not teach, show, or suggest an apparatus for connecting tubulars comprising a tong adapted to connect the tubulars and an extendable boom, the tong attached to one end of the extendable boom, wherein a center of mass of the tong is substantially aligned with an axis of the extendable boom, as recited in claim 64.

*Honea* does not teach, show, or suggest a method for connecting a first tubular to a second tubular. Further, actuating the extendable structure to move the tong toward a well center and engaging the first and second tubulars with the tong, as recited in claim 67. Therefore, Applicant believes the claims are in condition for allowance and respectfully requests allowance of the same.

### **35 U.S.C. § 103**

Claims 21-23, 37, 48, 49, and 52 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Honea* in view of *Murrill*, U.S. Patent No. 4,506,480. The Examiner states that *Honea* discloses all of the limitations of the above claims except for the actuating member including a piston and cylinder assembly that is at least partially located on the boom.

Claims 21-23, 37, 48-49, and 52 depend from independent claims 1, 35, 38, and 50. As discussed above, Applicant believes claims 1, 35, 38, and 50 are in condition for allowance. Therefore, Applicant also believes claims 21-23, 37, 48-49, and 52 are also in condition for allowance. Withdrawal of the rejection is respectfully requested.

### **35 U.S.C. § 103**

Claims 1-24 and 35-63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kelly*, U.S. Patent No. 3,881,375 in view of *Swoboda*, U.S. Patent No. 3,840,128. The Examiner states that *Kelly* discloses an apparatus for positioning a wellbore tong. The Examiner states that the apparatus includes the following features:

- A boom 24 with a tong T attached to the end thereof.
- A mounting assembly 10 coupled to an opposite end of the boom.

As such, the Examiner states *Kelly* discloses all of the limitations of the claims except for the boom being cantilevered and extendable via an actuating member. The Examiner further states *Swoboda* discloses an apparatus for moving a wellbore tubular gripping member similar to the apparatus of *Kelly*. The Examiner also states *Swoboda* teaches a cantilevered and extendable boom 36 and an actuating member for extending and retracting the extendable boom. The Examiner concludes that it would have been obvious to one of ordinary skill in the art to have modified *Kelly* to include the extendable boom of *Swoboda* in order to move a tubular member in any desired direction. The Examiner further concludes that one would have been motivated to make such a combination because a means for preventing swaying of the tubular, thus increasing the safety features on the drilling or workover rig, would have been obtained.

In order to establish a prima facie case of obviousness based on the prior art, the Examiner must show some "objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *Id.* at 1783-84.

Moreover, "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *Id.* at 1784.

*Kelly* discloses an apparatus for positioning a tong assembly T vertically with respect to joints of a string of drill pipe. (See, column 2, Ins. 47-50) The apparatus includes a vertical column with a support collar slidably disposed therearound. (See, column 2, Ins. 51-64) The collar is adapted to move upwardly and downwardly on the column. (See, column 2, Ins. 61-64) In operation, the tong is lowered to allow a pipe supporting elevator to retain and lower a pipe into the well bore. (See, column 3, Ins. 36-44) After the pipe is supported by the usual slip mechanism and the elevator is released, a next stand of pipe is then stabbed into the upper end of the pipe string. (See, column 3, Ins. 36-44) Then, the tong assembly T is elevated to a location at which the respective tongs are engageable with the tool joints. (See, column 3, Ins. 36-44) The tong is equipped with a pipe joint detecting means M that can scan the pipe to detect the joint as the tong assembly is being elevated. (See, column 4, Ins. 14-20) The tong, therefore, moves along a vertical track until it is adjacent a joint. Rather than use a telescopic boom to move the tong away from the well center when not in use, the tong swings out of the way along a fixed radius.

*Swoboda* discloses a racking arm having a pipe gripping head secured to an end of the arm. (See, column 2, Ins. 36-44) The racking arm guides movement of wellbore tubulars from various storage positions to a wellbore center. The gripping head may clamp the tubular for lateral movement while allowing the tubular to slide vertically along their axis, or to tightly grip the tubular for transportation. *Swoboda* does not teach making up or breaking out a tubular joint at well center. Rather, *Swoboda* is concerned with movement of the tubular to and from well center.

The Examiner has failed to provide a motivation or suggestion to combine the references, and instead, has impermissibly used the Applicant's disclosure as a template to piece together the prior art in order to render the Applicant's invention obvious. In her rejection, the Examiner states that the motivation to combine the references is to provide a means for preventing swaying of the tubular. As discussed above, the operation of *Kelly's* invention revolves around a tubular string having been

previously positioned at the well center; there is no lateral movement or swaying of the tubular string and no need to guard against it. Accordingly, the tong in *Kelly* is not used to move a tubular string to the well center. The lateral movement of the apparatus in *Kelly* is strictly for the purpose of removing the tong from well center when the tong is not in use. Further, as stated, the *Kelly* invention provides a means for swinging the tong to the side along a fixed radius. (See, column 2, Ins. 56-60) There is no indication in *Kelly* that such extension or retraction would serve any purpose. To the contrary, the *Kelly* specification indicates that the desired feature of moving the tong to and from a position aligned with the wellbore is fully achieved by the *Kelly* invention. (See, column 2, Ins. 57-59) The Examiner suggests that a combination of *Kelly* and *Swoboda* would further prevent swaying of the tubular. It would seem that the Examiner may have identified a point of novelty independent of *Swoboda* and/or *Kelly*. However, neither *Swoboda* nor *Kelly*, alone or in combination, teach, show, or suggest any such combination or requirement for such combined features. If fact, the apparatus of *Swoboda* is used in an operation for positioning a tubular, which is performed independently of the tubular connection operation using the *Kelly* apparatus. Further, the operations contemplated by the *Swoboda* apparatus and the *Kelly* apparatus occur sequentially and not in combination. Therefore, one of ordinary skill in the art would not be motivated to provide *Kelly*'s tong with the racking arm of *Swoboda*. Consequently, the Examiner has improperly used hindsight to combine the references to support the obviousness rejection. See In re Rouffet, 149 F.3d 350, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998)(hindsight is presumed when there is no motivation or suggestion to combine).

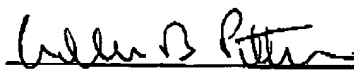
Thus, the references, neither alone nor in combination, teach, show, or suggest the inventions as recited in claims 1-24, 35-55, 57-62, and 64-69. Withdrawal of the rejection is respectfully requested.

### **Conclusion**

In conclusion, the reference cited by the Examiner, does not teach, show, or suggest the apparatus or methods of the present invention.

Having addressed all issues set out in the office action, Applicant respectfully submits that claims 1-24, 35-55, 57-62, and 64-69 are in condition for allowance and respectfully requests that the same be allowed.

Respectfully submitted,



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